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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,063

Applicant(s)

TERASE, TAKAO

Examiner

Andrew J. Fischer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10 and 12-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10 and 12-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Acknowledgments

1. The amendment filed October 30, 2003 (Paper No. 5) is acknowledged. Accordingly, claims 3-10 and 12-33 remain pending.

Specification

2. The substitute specification filed with Paper No. 5 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5, 7, 8, 12-19, 21, 26, 29, 30, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 5 recites the limitation "the cooked dishes" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is unclear what is "the cooked dishes."
- b. In claim 7, it is unclear what are "routes to vacant tables."
- c. Claim 14 does not make grammatical sense. "A claim must be read in accordance with the precepts of English grammar." *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

d. In claim 18, it is not clear if “a respective terminal receptacle” is the same or different from the “terminal receptacle” recited in claim 3.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 3-7, 9-17, 20-28, and 30-32, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by McHale, IV et. al. (U.S. 2002/0038165 A1)(“McHale”).

McHale discloses a portable, table top terminal (102); a kitchen terminal (112); an accounting unit (math coprocessor within 104); a control unit (104); a terminal receptacle (computer chassis, or alternatively, the tabletop itself); the portable table top terminal is ready for use when placed on the terminal receptacle (inherent since not only is it ready for use when placed on the terminal receptacle, it is ready for use *prior to* being placed in or on the terminal receptacle); data is

transmitted and received using radio communications between the portable table top terminal, the kitchen terminal, the accounting unit, and control unit (paragraph no. 0063); wherein information indicating cooked dishes is input on the kitchen terminal and transmitted to the portable terminal (touching the 'item' icon in 0107); a worktable terminal (114) is configured to indicate a table to be served in response to the information representing the cooked dishes; a guide display is configured to indicate at least vacant tables (the seater station in 0086); a head office terminal is configured to transmit visual indications of new menus or commercials (108); a flat panel display (inherent within 124); the portable table top terminals and the kitchen terminal are configured to recognize an employee terminal operator name and a terminal identification number (inherent in the tabletop computer since it must recognize which table ordered the particular dish and thus the wait staff); the portable table top terminals and the kitchen terminal are configured to input a terminal employee name and a terminal time of input (wait staff name and time the dish was ordered); the portable table top terminal is configured to be used at a counter or counter seat (*e.g.* near a patron sitting at the bar); the portable table top terminal is configured to indicate an operational status (on or off); an Internet connection (0010); the table top terminal comprises a visual display (the monitor); a connection to a POS network (*e.g.* credit card network); configured to transmit sales data from a head office to update an existing menu (inherent within the network in Figure 1); the table top terminal is configured to display out of stock items (its configured to display virtually all items at least by description); an order status device (a subroutine with the main computer program running the system) configured to indicate when ordered items are not available (*i.e.* out of stock); the kitchen terminal is configured to indicate a

product-ready indication and transmit the indication to the portable table top terminal (touching the 'item' icon in 0107); the terminal is configured to indicate material information (inherent since they can display practically any information in the system); an image input unit (the Internet) capable of creating a menu (*e.g.* Figure 9); an analysis unit (subroutine with operating software) configure to collect data; a communications device; the table top terminal is configured is configured to terminate an order (cancel or turn the terminal off); the table top terminal is configured specify a time for service (because times are input into the system, an approximate time for service can be calculated); the working status of employees is continuously monitored (inherent in the manager visually observing the employees) and a work command is issued to idle employees (inherent when the manager states, "Get off your lazy @#\$\$%^&* and get to work!" or "please check on table 5, they need assistance"); and the portable table top terminal is configured to display a sum of ordered items (the total bill).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-7, 9-17, 20-28, and 30-32, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over McHale in view of Cavello (U.S.

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5,699,226).¹ It is the Examiner principle position that claims 3-7, 9-17, 20-28 are anticipated because the terminal receptacle is inherent. Alternatively if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify McHale as taught by Cavello to include Cavello's receptacle (docking station). Such a modification would have prevented the computer from being stolen or knocked onto the floor.

9. Claims 8 and 18, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over McHale in view of Yuter (U.S. 4,800,438). McHale discloses as discussed above but does not directly disclose a phone system. Yuter teaches a phones system and alarm to, inter alia, get the assistance of the wait staff. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify McHale as taught by Yuter to include a phones system and alarm. Such a modification would have allowed the customers in McHale to talk directly with a manger who is not readily available in the restaurant. This rejection relies on the anticipation rejection of claims 3-7 and 15 noted above.

10. Claims 8 and 18 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over the McHale/Cavello combination in further view of Yuter. The McHale/Cavello combination discloses as discussed above but does not directly disclose a phone system. Yuter teaches a phones system and alarm to, inter alia, get the assistance of the wait staff. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the McHale/Cavello combination as taught by Yuter to include a phones system and

¹ See MPEP §2112 expressly authorizing alternative §102 or §103 rejections when the question of inherency is present in the anticipation rejection.

alarm. Such a modification would have allowed the customers in McHale to talk directly with a manger who is not readily available in the restaurant. This alternative rejection relies on the obviousness rejection of claims 3-7 and 15 noted above.

11. Claim 19, as understood by the Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over McHale in view of Duphorne (U.S. 6,212,265 B1). McHale discloses as discussed above but does not directly disclose an email system. Duphorne teaches using an email system to receive food orders sent by a customer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify McHale as taught by Duphorne to include sending email between terminals. Such a modification would have allowed the customers in McHale to communicate with other customers (such as in a dating service). This rejection relies on the anticipation rejection of claim 14 noted above.

12. Claim 19, as understood by the Examiner, is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over The McHale/Cavello combination in further view of Duphorne. The McHale/Cavello combination discloses as discussed above but does not directly disclose an email system. Duphorne teaches using an email system to receive food orders sent by a customer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the McHale/Cavello combination as taught by Duphorne to include sending email between terminals. Such a modification would have allowed the customers in McHale to communicate with other customers (such as in a dating service). This alternative rejection relies on the obviousness rejection of claim 14 noted above.

13. Claim 29, as understood by the Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over McHale in view of Kono (U.S. 6,229,694 B1). McHale discloses as discussed above but does not directly disclose a device configured to verbally repeat contents of orders. Kono teaches a device configured to verbally repeat information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify McHale as taught by Kono to include a device configured to verbally repeat contents of orders.. Such a modification would have helped visually impaired customers confirm their orders. This rejection relies on the anticipation rejection of claim 14 noted above.

14. Claim 29, as understood by the Examiner, is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over the McHale/Cavello combination in view of Kono. The McHale/Cavello combination discloses as discussed above but does not directly disclose a device configured to verbally repeat contents of orders. Kono teaches a device configured to verbally repeat information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the McHale/Cavello combination as taught by Kono to include a device configured to verbally repeat contents of orders.. Such a modification would have helped visually impaired customers confirm their orders. This alternative rejection relies on the obviousness rejection of claim 14 noted above.

15. Regarding the conditional language such as the language (i.e. "if not placed on a respective terminal receptacle" as recited in claim 18), Applicant is reminded that "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to

a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]” MPEP §2106 II C.

16. The Examiner notes that the claimed system includes elements that are “configured to” do this and “configured to” do that. By using “configured to” language, Applicants have not claimed that the claimed machine *actually performs* any of the “configured to” actions. With the proper software, the standard PC is “configured to” perform virtually unlimited number of functions. By placing e.g. a housing around the motherboard and other devices, the standard PC is configured to sit upon a desktop and perform all the various claimed functions.² Therefore, the functional recitations using “configured to” are inherent. If Applicants desire to have the “configured to” phrases to have greater patentable significance, the Examiner respectfully recommends Applicant include e.g. “receiving and indicating a dish ordered from the portable desk top terminal” (as in claim 3) or similar positively recited, claim language. Applicant is reminded that when interpreting functional language, if the prior art is capable of performing the claimed function—even if not directly disclosed—it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (Applicant’s popcorn dispenser was rejected with an oil can because the functional limitations were inherent in the reference).

17. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the

² Cf. a computer imbedded within a watch which is *not* configured to perform the claimed functions.

claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*. Upon appropriate resolution of the 35 U.S.C. §112 rejections, the claims will be reinterpreted to access claim scope and if not allowable, have the best prior art applied to the claims.

18. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,³ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements.⁴ Third, after receiving express notice in the previous Office Action⁵ of the Examiner’s position that lexicography is *not* invoked, Applicant has not pointed out the

³ See the Examiner’s previous Office Action mailed July 30, 2003, Paper No. 4, Paragraph No. 9.

⁴ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ See again the Examiner’s previous Office Action, Paper No. 4, Paragraph No. 9.

“supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicant has not argued lexicography *is* invoked). Finally and to be sure of Applicant’s intent, the Examiner also notes that Applicant has declined the Examiner’s express invitation⁶ to be his own lexicographer.⁷ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁸ The Examiner now relies heavily and extensively on this interpretation.⁹

⁶ *Id.*

⁷ The Examiner’s requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner’s requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed January 8, 2004).

⁸ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification.”); MPEP §§ 2111 and 2111.01; and *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁹ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

19. Under the broadest reasonable interpretation standard noted above, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action.¹⁰ Those previous definitions, like the definitions contained in this Office Action, are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences¹¹ claim interpretations) during ex parte examination. Therefore, to the extent that the Examiner's interpretations are different from Applicant's interpretations, the Examiner additionally adopts the following definition(s)—under the broadest reasonable interpretation standard—in all his claim interpretations. Finally, the Examiner notes that the following definition(s) (like the definitions from the previous Office Action) are not intended to be exhaustive in any way:

a. ***Portable Computer*** “Any computer designed to move easily.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.¹²

¹⁰See the Examiner's previous Office Action, Paper No. 4, Paragraph No. 10.

¹¹ See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (“[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.”).

¹² Based upon Applicant's disclosure, the art now of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the

20. With respect to the pending claims, the Examiner notes the following: "A system is an apparatus." *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, "[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner's position that Applicant's system claims are "product," "apparatus," or more specifically, "machine" claims.¹³

Response to Arguments

21. Applicant's arguments filed October 30, 2003 (Part of Paper No. 5) have been fully considered but they are not persuasive.

22. Applicant argues that McHale does not disclose "'a terminal receptacle provided on at (sic) a customer location and configured to receive a portable table top terminal thereon.'" ¹⁴ The Examiner respectfully disagrees. First, the computer chassis is a terminal receptacle. Claim 3 is therefore anticipated. Moreover, an ordinary restaurant tray (inherent at a restaurant) would also

Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as "a technical dictionary" to define the term "flag." See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled "New Terminology."

¹³ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

¹⁴ E.g., see Applicant's Remarks/Arguments, Paper No. 5, Page 12, ~ lines 20 and 21.

meet this limitation. Alternatively, the docking station provides this structure in the obviousness rejection.

23. Applicant's other arguments with respect to the claims have also been considered but are moot in view of the new grounds of rejection.

Conclusion

24. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

25. The prior art made of record considered pertinent to Applicant's disclosure includes the following: Brown et. al. (U.S. 6,646,659 B1); Ragssale-Elliot et. al. (U.S. 6,636,835 B2); Koester (U.S. 6,594,502 B1); Showghi et. al. (U.S. 6,473,739 B1); Katz (U.S. 6,327,575 B1); Kinebuchi et. al. (U.S. 6,208,976 B1); and Herlot et. al. (U.S. 6,185,096 B1).

26. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

27. It is the Examiner's factual determination that all limitations in the pending claims have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

28. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and

enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

29. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety.

Moreover, because these three references are directed towards beginners (see e.g. “User Level Beginning . . .”), because of the references’ basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

30. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant(s) with notice—for due process purposes—of his position regarding his

factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks/Arguments" (Paper No. 5 beginning on page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied¹⁵, the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in his next properly filed response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Patent Examiner

AJF
January 8, 2004

¹⁵ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.